

UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 78/523456

APPLICANT: Timezone Trademark Management Limited



CORRESPONDENT ADDRESS:

JESS M. COLLEN
COLLEN IP, INTELLECTUAL PROPERTY LAW, P.
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OSSINING, NY 10562

RETURN ADDRESS:

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

If no fees are enclosed, the address should
include the words "Box Responses - No Fee."

MARK: TIMEZONE

CORRESPONDENT'S REFERENCE/DOCKET NO: 92235

Please provide in all correspondence:

CORRESPONDENT EMAIL ADDRESS:

1. Filing date, serial number, mark and applicant's name.
2. Date of this Office Action.
3. Examining Attorney's name and Law Office number.
4. Your telephone number and e-mail address..

Serial Number 78/523456

Applicant is requesting reconsideration of a final refusal dated February 7, 2006.

Applicant has filed a notice of appeal and the appeal was suspended for consideration of the request for reconsideration.

Applicant's request for reconsideration restates previous positions regarding the similarity of the marks and goods/services. No new evidence is presented.

THE MARKS

Applicant contends the following:

The entire appearance of the mark, especially when viewed in the context of the services marketed under the mark, creates a unique commercial impression and appearance. Applicant submits that it is this distinguishing characteristic which completely differentiates Applicant's mark from the cited registrations.

Applicant's mark shows the term "TimeZone" used where circles resembling clock faces form the two letters "e" and the vowel "o." Registrant's mark in the '691 registration is TIMEZONE in typed drawing form. The '379 registration shows the term TIMEZONE in stylized form with triangular line designs before and after the word.

Applicant indicated in its application papers that the literal element of the mark is TIMEZONE. This is consistent with a review of the design mark. Given the presence of clock face designs where the vowels "e" and "o" would appear, the ordinary person would likely read the mark as TIMEZONE. Further,

anyone referring to the mark would call for it as TIMEZONE.

It is well settled that in 2(d) analysis marks are compared for similarities in sound, appearance, meaning or connotation. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973).

Similarity in any one of these elements may be sufficient to find a likelihood of confusion. *In re White Swan Ltd.*, 8 USPQ2d 1534, 1536 (TTAB 1988); *In re Lamson Oil Co.*, 6 USPQ2d 1041, 1043 (TTAB 1987); *In re Mack*, 197 USPQ 755 (TTAB 1977); TMEP §1207.01(b). Applicant's mark is identical in sound and meaning and similar in appearance. The marks are confusingly similar.

Applicant contends that there are other marks registered that contain the term TIMEZONE or TIME ZONE. However, a review of the register indicates that cited registrations are the only marks for TIMEZONE or TIME ZONE registered in either International Class 14 or 35. The mark appears to be strong vis-à-vis the goods/services in question.

THE GOODS AND SERVICES

Applicant seeks to register its mark for services described as "Retail stores; import and export agencies; **advertising, marketing and promotion services**; business information services; dissemination of advertising matter; demonstration of products; distribution of samples; shop window dressing; arranging exhibitions for business and advertising purposes; **business advisory and consultancy services**; **all of the above featuring watches, clocks, horological and chronometric instruments.**"

The services in the '691 registration include "Advertising agencies and business management services." The services covered by applicant and registrant are either identical or essentially identical. No limitations on channels of trade appears in either the cite or the application here.

The goods in the '479 registration include electronic watches and electronic clocks. Applicant's retail store services feature watches and other chronometers. Attached are several registrations showing the same mark registered for both watches and retail services. Persons aware of registrant's watches and clocks would likely believe there is a connection between those instruments and applicant's services.

Applicant seems to believe that purchasers of these goods would be sophisticated. This may or may not be so, generally, but where the relevant consumer is comprised of both professionals and the general public, the standard of care when purchasing the goods is equal to that of the least sophisticated purchaser in the class. *Alfacell Corp. v. Anticancer Inc.*, 71 USPQ2d 1301, 1304 (TTAB 2004) (as stated in *KOS Pharmaceuticals Inc., v. Andrx Corp.*, 369 F.3d 700, 70 USPQ2d 1874 (3d Cir. 2004), and citing *Checkpoint Sys., Inc., v. Check Point Software Techs., Inc.*, 269 F.3d 270, 285, 60 USPQ2d 1609, 1617-1618 (3d Cir. 2001)).

CONCLUSION

After careful consideration of the law and facts of the case, the examining attorney must deny the request for reconsideration and adhere to the final action as written since no new facts or reasons have been presented that are significant and compelling with regard to the point at issue.

Accordingly, applicant's request for reconsideration is *denied*. The file will be returned to the Trademark Trial and Appeal Board for further action. 37 C.F.R. Section 2.64(b); TMEP Section 715.03 (c).

/Chris Wells/
Examining Attorney
Law Office 106
(571) 272-9238
FAX (571) 273-9105

Print: Sep 7, 2006

78148029

TYPED DRAWING

Serial Number

78148029

Status

REGISTERED

Word Mark

FANOUS

Standard Character Mark

No

Registration Number

3122537

Date Registered

2006/08/01

Type of Mark

TRADEMARK; SERVICE MARK

Register

PRINCIPAL

Mark Drawing Code

(1) TYPED DRAWING

Owner

Famous Diamonds, Inc. CORPORATION TEXAS 3214 N. First Street Abilene
TEXAS 79601

Goods/Services

Class Status -- ACTIVE. IC 014. US 002 027 028 050. G & S:
Jewelry, watches, clocks, jewelry boxes, crystal, precious gemstones,
and giftware made of precious metals, namely, jewelry, charms,
cufflinks, tie clips, tie tacks, and key chains. First Use:
2002/03/01. First Use In Commerce: 2002/03/01.

Goods/Services

Class Status -- ACTIVE. IC 035. US 100 101 102. G & S: Retail
store services in the field of jewelry, watches, precious gems and
giftware. First Use: 2002/03/01. First Use In Commerce: 2002/03/01.

Goods/Services

Class Status -- ACTIVE. IC 042. US 100 101. G & S: Design services
in the field of jewelry. First Use: 2002/03/01. First Use In
Commerce: 2002/03/01.

Filing Date

Print: Sep 7, 2006

78148029

2002/07/26

Examining Attorney
PERRY, KIMBERLY

Attorney of Record
R. Darryl Burke

Print: Sep 7, 2006

78237662

TYPED DRAWING

Serial Number

78237662

Status

REGISTERED

Word Mark

ORO KING

Standard Character Mark

No

Registration Number

3136453

Date Registered

2006/08/29

Type of Mark

TRADEMARK; SERVICE MARK

Register

PRINCIPAL

Mark Drawing Code

(1) TYPED DRAWING

Owner

Oro King, Inc. CORPORATION CALIFORNIA 550 S. Hill Street, Suite 1511
Los Angeles CALIFORNIA 90013

Goods/Services

Class Status -- ACTIVE. IC 014. US 002 027 028 050. G & S:
Jewelry, namely watches, watch bands and straps, bracelets, brooches,
jewelry pins, jewelry, jewelry chains, rings, watch chains, charms,
earrings and necklaces. First Use: 1998/04/02. First Use In
Commerce: 1998/04/02.

Goods/Services

Class Status -- ACTIVE. IC 035. US 100 101 102. G & S: Retail
store, wholesale and mail-order catalog services featuring jewelry.
First Use: 1998/04/02. First Use In Commerce: 1998/04/02.

Disclaimer Statement

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "ORO" APART FROM THE
MARK AS SHOWN.

Translation Statement

The English translation of the word "ORO" is "GOLD".

Print: Sep 7, 2006

78237662

Filing Date

2003/04/14

Examining Attorney

ELLIN, INGRID

Attorney of Record

Doug Lipstone

Print: Sep 7, 2006

78597183

DESIGN MARK

Serial Number

78597183

Status

REGISTERED

Registration Number

3106335

Date Registered

2006/06/20

Type of Mark

TRADEMARK; SERVICE MARK

Register

PRINCIPAL

Mark Drawing Code

(2) DESIGN ONLY

Owner

PROMAX INTERNATIONAL HOLDINGS LIMITED CORPORATION BR.VIRGIN ISLANDS
P.O.Box 3152 Roda Town, Tortola BR.VIRGIN ISLANDS

Goods/Services

Class Status -- ACTIVE. IC 009. US 021 023 026 036 038. G & S:
Swim goggles, hydrosopes, ski goggles, electronic blackboards,
computer liquid crystal displays, cases for photographic equipment,
television sets, eyeglasses, magnifying glasses, telescopes, liquid
crystal displays. First Use: 2002/08/30. First Use In Commerce:
2002/09/06.

Goods/Services

Class Status -- ACTIVE. IC 014. US 002 027 028 050. G & S:
watches, watch chains, clocks, bracelets, necklaces, earrings, rings,
key-rings of precious metal, tiepins, jewelry, jewelry boxes of
precious metal, brooches of precious metal, badges of precious metal.
First Use: 2002/08/30. First Use In Commerce: 2002/09/06.

Goods/Services

Class Status -- ACTIVE. IC 035. US 100 101 102. G & S: Retail
store, computerized online retail and retail distributorship services
all featuring eyeglass cleaning cloths, swim goggles, hydrosopes, ski
goggles, electronic blackboards, computer liquid crystal displays,
camera cases, television sets, eyeglasses, magnifying glasses,
telescopes, liquid crystal displays, trunks, luggage, briefcases,
traveling bags, backpacks, school bags, shopping bags, handbags, waist
packs, vanity cases sold empty, purses, wallets, umbrellas, walking

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78597183

sticks, clothing, footwear, headgear, gloves, neckties, scarves belts, watches, clocks, bracelets, necklaces, neck-rings, key-rings of precious metal; import and export agency services of the aforementioned products. First Use: 2002/08/30. First Use In Commerce: 2002/09/06.

Prior Registration(s)

2866057

Filing Date

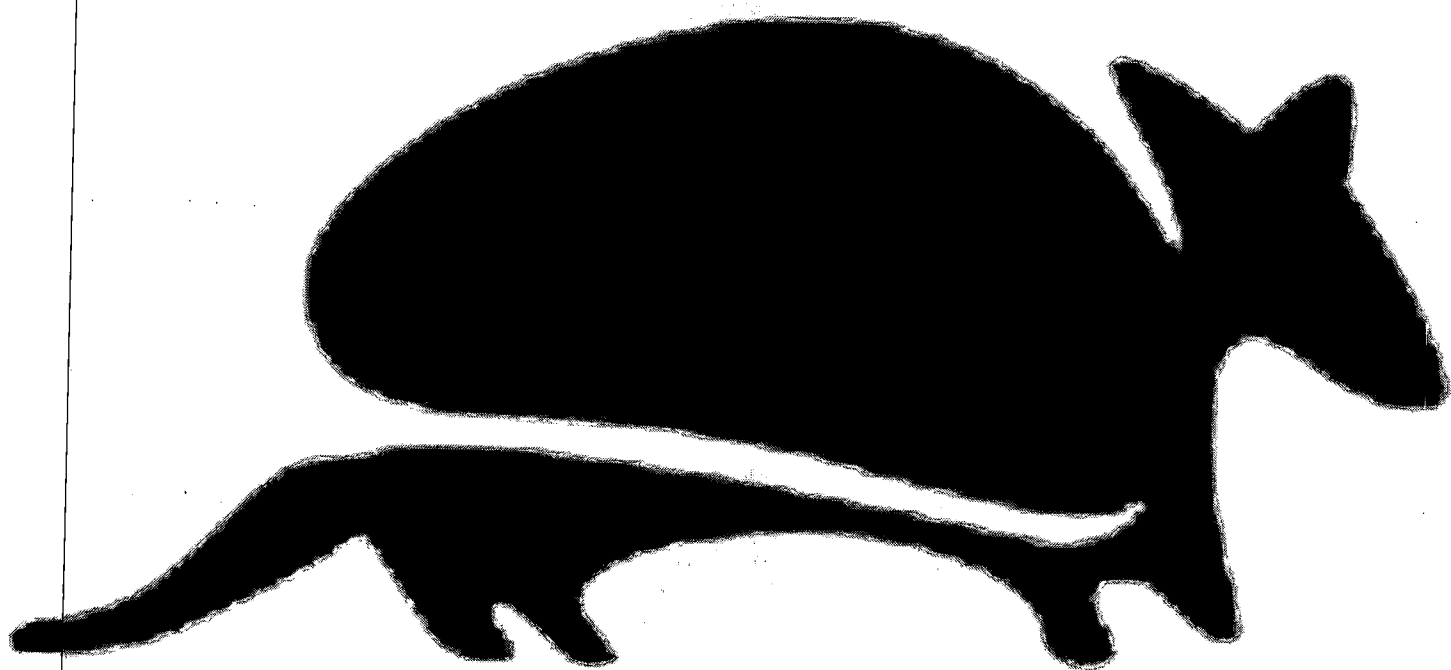
2005/03/29

Examining Attorney

MCMORROW, RONALD

Attorney of Record

Micheal D. Schumann



Print: Sep 7, 2006

78666736

DESIGN MARK

Serial Number

78666736

Status

REGISTERED

Word Mark

BROOKS BROTHERS

Standard Character Mark

Yes

Registration Number

3029206

Date Registered

2005/12/13

Type of Mark

TRADEMARK; SERVICE MARK

Register

PRINCIPAL

Mark Drawing Code

(4) STANDARD CHARACTER MARK

Owner

Retail Brand Alliance, Inc. CORPORATION DELAWARE 100 PHOENIX AVENUE
ENFIELD CONNECTICUT 06082

Goods/Services

Class Status -- ACTIVE. IC 003. US 001 004 006 050 051 052. G & S: cosmetics and toiletries, namely, emery boards, cologne, cologne spray, after-shave lotion, after-shaving balms, shaving cream, soap, deodorant for personal use, shampoo, styling gels, body lotion, body gel, fragrances for personal use, body creams, shower gels, skin cleansing cream, and skin and body lotions for personal use. First Use: 1964/09/13. First Use In Commerce: 1964/09/13.

Goods/Services

Class Status -- ACTIVE. IC 008. US 023 028 044. G & S: Nail implements, namely, fingernail and toenail clippers, tweezers, cuticle nippers and scissors, and nail buffers; flatware, namely, forks, table and kitchen knives and spoons; pocket knives. First Use: 1948/12/31. First Use In Commerce: 1948/12/31.

Goods/Services

Class Status -- ACTIVE. IC 009. US 021 023 026 036 038. G & S:

Eyeglasses, comprising spectacles, spectacle frames, sunglasses, eyeglass chains, eyeglass retaining bands, eyeglass cases and lens; binoculars, tape measures and pedometers, calculators, electronic calendars, electrically operated shoe shine units; barometers; electric or battery operated travel irons, voltage conversion devices. First Use: 1993/03/31. First Use In Commerce: 1993/03/31.

Goods/Services

Class Status -- ACTIVE. IC 014. US 002 027 028 050. G & S: Watches, watchbands, clocks, key chains made of precious metal, and jewelry. First Use: 1948/12/31. First Use In Commerce: 1948/12/31.

Goods/Services

Class Status -- ACTIVE. IC 016. US 002 005 022 023 029 037 038 050. G & S: Tie Cases Made of Cardboard and Covered with Paper or Fabric and Sold Empty, Shoe Bags for Travel, Garment Bags for Travel, diaries; thesauri; dictionaries; books on a variety of subjects, namely, history, wine, dining, etiquette, fashion, public speaking, and game rule books; personal organizers; calendars; stationery; gift wrapping paper; gift boxes; gift bags; appointment books; greeting cards; mail order catalogs featuring all of the foregoing as well as clothing and accessories, and cosmetics. First Use: 1903/01/03. First Use In Commerce: 1903/01/03.

Goods/Services

Class Status -- ACTIVE. IC 018. US 001 002 003 022 041. G & S: Handbags, tote bags, backpacks, luggage, wallets, purses, key cases, briefcases, duffel bags, all-purpose sport bags, business card cases, credit card cases; briefcase-type portfolios, billfolds, tie case, attaché cases, passport cases and umbrellas. First Use: 1903/01/13. First Use In Commerce: 1903/01/13.

Goods/Services

Class Status -- ACTIVE. IC 020. US 002 013 022 025 032 050. G & S: picture frames, furniture and pillows. First Use: 1981/12/31. First Use In Commerce: 1981/12/31.

Goods/Services

Class Status -- ACTIVE. IC 021. US 002 013 023 029 030 033 040 050. G & S: Hair combs and brushes, serving spoons and forks not made of metal; woodenware, porcelain and china, namely, dishes, bowls, plates, serving platters, salad bowls, salad servers, cake servers, cups, saucers, salt and pepper shakers, non-electric coffee pots, tea pots not made of metal, containers for serving cream not made of metal, napkin holders, napkin rings not of precious metal, candlestick holders not made of metal, vases and pitchers; crystal and glass beverage glassware, namely, cocktail shakers, mugs, goblets, wineglasses, coasters, decanters, pitchers, bowls, vases, carafes, flasks, ice buckets, ice tongs not made of metal; ceramic and laminated accessories, namely, soap dishes and toothbrush holders; corkscrews. First Use: 1914/00/00. First Use In Commerce:

1914/00/00.

Goods/Services

Class Status -- ACTIVE. IC 024. US 042 050. G & S: bed sheets, comforters, bed blankets, dust ruffles, duvet covers, pillow cases, pillow shams, bed shams, bed spreads, shower curtains, towels, wash cloths, fabric napkins, fabric placemats, fabric tablecloths and curtains. First Use: 1903/01/03. First Use In Commerce: 1903/01/03.

Goods/Services

Class Status -- ACTIVE. IC 025. US 022 039. G & S: Men's, women's, boy's and girl's shirts, tops, sweaters, jackets, pants, suits, bottoms, socks, hats and caps; shoes; shorts, coats, neckties, underwear, vests, robes, hosiery, skirts, dresses, loungewear, scarves, rainwear, trousers, ascots, ties, outer shirts including evening, dress, polo and sports shirts, collars, pajamas, robes, smoking jackets, dressing gowns, mufflers, gloves, hose, belts, suspenders, garters, boots, slippers, shoes, overshoes, beach wear, swimwear, and formal wear, namely, jackets, pants, suits, shirts, shoes, cummerbunds, ties, suspenders and gowns. First Use: 1856/00/00. First Use In Commerce: 1856/00/00.

Goods/Services

Class Status -- ACTIVE. IC 027. US 019 020 037 042 050. G & S: wallpaper. First Use: 2005/03/31. First Use In Commerce: 2005/03/31.

Goods/Services

Class Status -- ACTIVE. IC 028. US 022 023 038 050. G & S: Golf accessories and golf equipment, namely, divot tools, ball markers, golf balls, golf clubs, golf bags, golf ball washers, non-motorized golf carts, golf tees, and golf club covers. First Use: 1903/03/31. First Use In Commerce: 1903/03/31.

Goods/Services

Class Status -- ACTIVE. IC 035. US 100 101 102. G & S: retail store services, online retail store services and mail order catalog services featuring clothing for men, women and children, sporting goods, eyewear, fragrance, body lotions, housewares, personal accessories and luggage. First Use: 1818/00/00. First Use In Commerce: 1818/00/00.

Prior Registration(s)

1835478;1835798;1839876;AND OTHERS

Filing Date

2005/07/08

Examining Attorney

RINGLE, JIM

Attorney of Record

Print: Sep 7, 2006

78666736

Stephen L. Baker

BROOKS BROTHERS

Print: Sep 7, 2006

78975375

TYPED DRAWING

Serial Number

78975375

Status

REGISTERED

Word Mark

ELLEN TRACY

Standard Character Mark

No

Registration Number

2863810

Date Registered

2004/07/13

Type of Mark

TRADEMARK; SERVICE MARK

Register

PRINCIPAL

Mark Drawing Code

(1) TYPED DRAWING

Owner

L.C. Licensing, Inc. CORPORATION DELAWARE 1441 Broadway New York NEW YORK 10018

Goods/Services

Class Status -- ACTIVE. IC 003. US 001 004 006 050 051 052. G & S: POTPOURRI; PERFUMES, COLOGNES, TOILET SOAP, SKIN MOISTURIZING CREAM, SKIN CLEANING CREAM, FACE POWDER, LIPSTICK, NAIL ENAMEL, EYESHADOW, MASCARA, LIQUID FOUNDATION, TANNING OIL, HAIR SHAMPOOS, HAIR CONDITIONERS, HAIR RINSES; PERFUMED TALC, AFTER SHAVE LOTION, SHAVING LOTION, PERSONAL DEODORANT AND BATH SOAP. First Use: 1998/06/30. First Use In Commerce: 1998/06/30.

Goods/Services

Class Status -- ACTIVE. IC 009. US 021 023 026 036 038. G & S: SUNGLASSES, EYEGLASSES, EYEGLASS FRAMES, EYEGLASS CASES AND EYEGLASS CORDS; CELLULAR TELEPHONE CASES. First Use: 1999/04/01. First Use In Commerce: 1999/04/01.

Goods/Services

Class Status -- ACTIVE. IC 014. US 002 027 028 050. G & S: WATCHES; NECKLACES, EARRINGS, BRACELETS, PINS BEING JEWELRY, RINGS

Print: Sep 7, 2006

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BEING JEWELRY. First Use: 2003/08/01. First Use In Commerce: 2003/08/01.

Goods/Services

Class Status -- ACTIVE. IC 018. US 001 002 003 022 041. G & S: UMBRELLAS, HANDBAGS, WALLETS, CHANGE PURSES, CLUTCH PURSES, BRIEFCASE-TYPE PORTFOLIOS, COSMETIC AND TOILETRY CASES SOLD EMPTY; BRIEFCASES, KEY CASES, AND ATTACHE CASES. First Use: 2003/08/01. First Use In Commerce: 2003/08/01.

Goods/Services

Class Status -- ACTIVE. IC 035. US 100 101 102. G & S: RETAIL STORE SERVICES. First Use: 2003/10/07. First Use In Commerce: 2003/10/07.

Prior Registration(s)

1780391;2019898;2147126;2688367;2773350;AND OTHERS

Name/Portrait Statement

The name "ELLEN TRACY" does not identify a living individual.

Filing Date

2002/09/30

Examining Attorney

BLANDU, FLORENTINA

Attorney of Record

David B. Kirschstein, Esq.